

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID C. IRVING

Appeal No. 98-1460
Application No. 08/615,820¹

ON BRIEF

Before MEISTER, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 19, which are all of the claims pending in this application.²

¹ Application for patent filed March 14, 1996.

² Claims 17 and 18 were amended subsequent to the final rejection resulting in the sub silentio withdrawal of the rejection of claims 17 and 18 under 35 U.S.C. § 112, second paragraph, which was made in the final rejection.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a built-up I-beam with laminated flange. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Keller et al. (Keller)	4,074,498	Feb. 21, 1978
Brightwell	4,715,162	Dec. 29, 1987
Onysko et al. (Onysko)	4,974,389	Dec. 4, 1990
Scarlett	5,323,584	June 28, 1994

Claims 1 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over any of Scarlett or Onysko or Brightwell in view of Keller.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 11, mailed November 26, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellant's

brief (Paper No. 10, filed September 2, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 19 under

35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of

obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification necessary to arrive at the claimed invention. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

All the claims on appeal require each flange of the I-beam to include or be made of or be formed of oriented strand lumber.

The appellant argues (brief, pp. 8-10) that no combination of the applied prior art (i.e., Scarlett, Onysko,

Brightwell and Keller) discloses or suggests the use of oriented strand lumber³ (OSL) as an I-beam flange material. We agree. In addition, we agree with the appellant's rationale set forth on pages 10-13 of the brief and pages 4-6 of the specification as to why an artisan would not have used oriented strand lumber (OSL) as the flange material in any of the I-beams of Scarlett, Onysko, or Brightwell.

In response to this argument of the appellant the examiner states (answer, p. 5) that

Scarlett, Brightwell, and Onysko et al. teach utilization of "oriented strand lumber" as chord [flange] members as at col. 4, lines 23-25 of Scarlett or col. 3, lines 31-34 of Brightwell or col. 6, lines 29-33 of Onysko et al.

We have reviewed the entire disclosures of Scarlett, Brightwell and Onysko, especially those passages cited by the examiner, and fail to find any disclosure or suggestion therein to use oriented strand lumber (OSL) as an I-beam

³ The meaning of oriented strand lumber and the differences between oriented strand lumber and other types of engineered lumber are set forth on pages 3-4 of the appellant's specification.

flange material as recited in the claims under appeal. We have also reviewed the entire disclosure of Keller and fail to find any disclosure or suggestion therein to use oriented strand lumber (OSL) as an I-beam flange material.

Since the applied prior art does not suggest the use of oriented strand lumber (OSL) as an I-beam flange material as recited in the claims under appeal, the decision of the examiner to reject claims 1 through 19 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1 through 19 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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APPEAL NO. 98-1460 - JUDGE NASE
APPLICATION NO. 08/615,820

APJ NASE

APJ MEISTER

APJ STAAB

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 04 Feb 99

FINAL TYPED: